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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------|------------------|
| 10/034,528 | 12/27/2001 | Benjamin N. Eldridge | P6C3-US | 2563 |
| 50905 | 7590 | 10/11/2005 | EXAMINER | |
| N. KENNETH BURRASTON KIRTON & MCCONKIE P.O. BOX 45120 SALT LAKE CITY, UT 84145-0120 | | | ROBERT, RUSSELL MARC | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2829 | |

DATE MAILED: 10/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/034,528

Applicant(s)

ELDRIDGE ET AL.

Examiner

Russell M. Kobert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43, 48, 49, 51-57, 59-65 and 74-101 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43, 48, 49, 51-57, 59-65 and 74-101 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>1104 & 1005</u> | 6) <input type="checkbox"/> Other: _____ |

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1. The details of the prior Office Action mailed on December 27, 2001 are reiterated as follows in response to the RCE filed October 3, 2005.

2. Applicant's arguments, see page 11, lines 10-14, that asserts the subject matter of each of the claims is expressly directed to "a tested semiconductor device," and "not a probe card assembly or a combination of a probe card assembly and a tested semiconductor device", filed November 12, 2004, with respect to the rejection under 35 USC 112 has been fully considered and is persuasive. Moreover Applicant's arguments, see page 12, lines 8-14, that asserts the "product -- that is, the tested semiconductor device -- patentably differs from prior art semiconductor devices," filed November 12, 2004, with respect to the rejection under 35 USC 112 has been fully considered and is persuasive. Additionally, Applicant's arguments, see page 11, lines 15-22, that asserts "Applicants are not attempting to do what is forbidden Ex parte Lyell, 17 USPQ 1548 (Bd. Pat. App. & Inter. 1990), which was cited in the Office Action" and further states "the preambles of the claims in the present application are expressly directed only to a 'tested semiconductor device'," filed November 12, 2004, with respect to the rejection under 35 USC 112 have been fully considered and are persuasive. The rejection under 35 USC 112 of claims 43, 48, 49, 51-57, 59-65, 68 and 74-83 has been withdrawn.

In summary, Applicants' claimed invention is limited to only a tested semiconductor device and nothing more than a tested semiconductor device; no patentable weight being given to the process of producing the test semiconductor

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device and no patentable weight given to a probe card assembly including any details of the probe card assembly in view of Applicants' own admission in the Amendment filed November 12, 2004.

3. Applicant's most recent arguments with respect to claims 43, 48, 49, 51-57, 59-65 and 74-101 have been considered but are moot in view of the new ground(s) of rejection.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 43, 48, 49, 51-57, 59-65 and 74-101 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Littlebury (5012187).

Littlebury anticipates (Figure 2) a tested semiconductor device (semiconductor chips 12 tested in wafer form and reference made to processing memory chips 12 after testing; see col 2, ln 26-29 and col 4, ln 40-63) produced by providing a wafer (col 4, ln 11-16; Littlebury states the preferred embodiment being in wafer form) having a plurality of semiconductor devices (12) thereon, each of the semiconductor devices including a plurality of electrical contact terminals (13) as recited in claims 43 and 82.

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As to claim 48, dicing the wafer to singulate the semiconductor devices is anticipated by Littlebury (col 4, ln 11-18).

Littlebury anticipates the limitations of claims 49, 51-57, 59-65 and 74-81 and 83-101, because the additional limitations presented in each of claims 49, 51-57, 59-65 and 74-81 and 83-101 do not add patentable weight to the claimed invention and do not further narrow the scope of Applicants' claimed invention that is directed solely to "a tested semiconductor device."

6. A shortened statutory period for response to this action is set to expire three month(s) from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Kobert whose telephone number is (571) 272-1963. The Examiner's Supervisor, Nestor R. Ramirez, can be reached at (571) 272-2034. For an automated menu of Tech Center 2800 phone numbers call (571) 272-2800.



Russell M. Kobert
Patent Examiner
Group Art Unit 2829
October 6, 2005



VINH NGUYEN
PRIMARY EXAMINER

A. u. 2829

10/07/05